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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,167	01/09/2004	David Esberger	827.1.023	1278

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EXAMINER

GRILES, BETHANY L

ART UNIT PAPER NUMBER

3643

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/755,167

Applicant(s)

ESBERGER, DAVID

Examiner

Bethany L. Griles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8, 9, 11, 12, 17-20, 25-32 and 36 is/are rejected.
- 7) ☐ Claim(s) 5, 7, 10, 13-16, 21-24, 26-28, 33-35, 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The previous office action, mailed on 6/10/04 is withdrawn in view of the following action. The time period to respond has been restarted as to the mailing date of the instant office action.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 8, 9, 11, 12, 17-20, 25-32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnes US4501085.
3. Regarding claim 1, Barnes discloses a weight 18 comprising attachment means (column 3, line 17 discloses an eye for securing line to the lure (weight)); means (col 5, lines 14-24 describe the mechanism by which the weight is projected out of the device) for projecting the weight 18 into a body of water, wherein the means for projecting comprises: a barrel 15 having a bore, the bore 32 being adapted to receive the weight (col 3, lines 11, 12); a tank 54 adapted to hold a reservoir of compressed gas; and valve means 42 connected between the bore 32 and the tank 54 and operable to supply compressed gas from the tank to the bore to project the weight 18 out of the barrel.

4. Regarding claim 2, Barnes discloses that the weight is elongate, having a longitudinal axis which is aligned substantially parallel to the longitudinal axis of the bore when the weight is received within the bore (please see the orientation of elements 18 and 32 and their spatial relationship as depicted in figure 2B, which shows a parallel longitudinal axis between the two elements).
5. Regarding claim 3, Barnes discloses that the weight is generally cylindrical (see element 18 in figure 1).
6. Regarding claim 4, Barnes discloses that the weight is a tube filled with dense material, as the weight 18 in Barnes is described as "a weighted plug" (col 1, line 42). As the lure 18 is depicted in the drawings as a tube like structure, and since Barnes discloses that the lure is weighted, it would be inherent to the structure that it contained a material dense enough to be referred to as a "weight", and consists of a "dense material" as claimed by Applicant.
7. Regarding claim 8, Barnes discloses that the attachment means<sup>33</sup> is provided at one end of the weight.
8. Regarding claim 9, Barnes discloses attachment means (column 3, line 17 discloses an eye for securing line to the lure (weight)) in the form of an eye.
9. Regarding claim 11, Barnes discloses that the tank 54 is elongate having an outlet at one end 51, said outlet being in line with the valve means and the barrel (please refer to orientation of elements in figure 6).
10. Regarding claim 12, Barnes discloses that the tank 54 is generally cylindrical, as it fits within the cylindrical handle of the fishing rod 13.

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11. Regarding claims 17, 19, and 20, Barnes discloses an alternate embodiment of the invention which provides for a hose coupling to be fitted to the handle of the device via an inlet valve (col 5, lines 42-46).
12. Regarding claim 18, Barnes discloses that the valve is a non-return valve (col 5, line 55).
13. Regarding claim 25 and 29-32, Barnes discloses a base (Examiner asserts that a human being using the device could be defined as a "base") adapted to engage a ground surface and support the barrel in an inclined position (again, functions which could be performed by a human user).
14. Regarding claim 36, Barnes discloses a trigger valve 42 including a sealing member 51 from the valve seat to permit gas flow through the valve and a trigger mechanism 63 for triggering the hammer.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes in view of Borner US5444937.
17. Regarding claim 6, Barnes substantially discloses the invention as detailed in the previous claims.

18. Barnes does not disclose that the weight is spherical.
19. Borner discloses a spherical weight made up of two movable hemispheres (col 2, lines 13-14).
20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Borner of a spherical weight to the invention of Barnes, as it is old and well known in the art to have spherical lead weights which attach to fishing lines (see col 1, lines 12-17 for Borner's description of the state of the sinker art, which mentions weights which are "articulated about themselves").

***Allowable Subject Matter***

21. Claims 5, 7, 10, 13-16, 21-24, 26-28, 33-35, 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Neff et al. US2958975 ; Merz US2977706 ; Nicolavich et al. US5450839; West, Jr. US6244261; Kornblith US5398587.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bethany L. Griles whose telephone number is

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703.305.1839. The examiner can normally be reached on Monday through Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 703.308.2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bethany L. Griles  
Examiner  
Art Unit 3643

blg



Peter M. Poon  
Supervisory Patent Examiner  
Technology Center 3600

7/12/04